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10/007,696	12/10/2001	Gary Tessman JR.	06975-172001/Communicatio	9895

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FISH & RICHARDSON P.C.  
1425 K STREET, N.W.  
11TH FLOOR  
WASHINGTON, DC 20005-3500

EXAMINER

NGUYEN, MERILYN P

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/007,696

Applicant(s)

TESSMAN ET AL.

Examiner

Merilyn P Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: Detailed action.

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***DETAILED ACTION***

1. This application claims benefit of US provisional application 60/251,834 filed on December 8, 2000.
2. Claims 1-59 are pending in this office action as a result of the addition of claims 23-59.

***Acknowledges***

3. Receipt is acknowledged of the following items from the Applicant:
  - o Information Disclosure Statement (IDS) filed on December 10, 2001 and made of record as Paper No. 5. The references cited on the PTOL 1449 form have been considered.
  - o The applicant Preliminary amendment has been considered and made of record as Paper No. 7.

***Claim Objections***

4. Claim 33 is objected to because of:

At line 2, "ima ge" is suggested to change to --image--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-14, 15, 21, 25, 38, and 49-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 21, the preamble discloses a method for storing digital images. However, the body of the claim does not specifically describe how to storing digital images.

Regarding claim 4, 25, 38 and 50, there is insufficient antecedent basis for “translating the extracted storage path information” in the claim. It is unclear what the extracted storage path information is translated to.

Regarding claim 15, this claim is incomplete because it fails to recite essential structural limitations for carrying out the claimed steps.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-13, 15-34, 36-47, 49-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Stewart (US 6,389,460).

Regarding claims 1, 15, and 16, Stewart discloses a method of, an apparatus, and a computer program, stored on a computer readable medium, for storing digital images

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within a computer system (See col. 15, line 64 through col. 17, line 67) comprising: identifying (See col. 10, lines 65-67) a first storage facility (214, Fig. 2) and a directory within the first storage facility for storing a digital image (See col. 10, lines 55-67); generating a first image identifier (url) associated with the first storage facility and the directory and a second image identifier comprising a random number (cookies) (See col. 16, lines 33-40, wherein the image identification string is formed corresponding to first and second identifiers); generating a unique hash value by encrypting the first and second image identifiers (See col. 16, lines 49-59); identifying a storage path using the first and second image identifiers and the unique hash value such that related digital images have unrelated storage paths (See col. 17, lines 8-45, and Fig. 8 and corresponding text).

Regarding claim 21, Stewart discloses a method of storing digital images within a computer system (See col. 15, line 64 through col. 17, line 67) comprising: generating at least one image identifier (See col. 16, lines 33-40) associated with a first storage facility (214, Fig. 2), a directory (Fig. 8) within the first storage facility (See col. 10, lines 55-67, and more detail in col. 20, lines 12-25), and a random number (See col. 16, lines 33-40); and identifying a storage path using the at least one image identifier such that related digital images have unrelated storage paths (See col. 17, lines 8-45, and Fig. 8 and corresponding text).

Regarding claims 2, 23, and 36, Stewart discloses wherein the digital image is received from at least one of a subscriber of the computer system and a third party associated with the subscriber (See col. 14, lines 40-59).

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Regarding claims 3, 24, 37, and 49, Stewart discloses wherein identifying a storage path comprises extracting storage path information from at least one of the first image identifier and the second image identifier (See col. 17, lines 8-12).

Regarding claims 4, 25, 38, and 50, Stewart discloses translating the extracted storage path information (See col. 17, lines 12-13).

Regarding claims 5, 26, 39, and 51, Stewart discloses wherein identifying a storage path comprises using the unique hash value as a filename (See col. 11, lines 32-39, and col. 26, lines 4-11).

Regarding claims 6, 27, 40, and 52, Stewart discloses storing the digital image in the first storage facility at the identified storage path (See col. 5, lines 1-4, and col. 20, lines 12-49).

Regarding claims 7, 28, 41, and 53, Stewart discloses generating and storing lower resolution thumbnails (compress form) at the identified storage path (See col. 7, lines 15-22, and col. 15, lines 29-35).

Regarding claims 8, 29, 42, and 54, Stewart discloses identifying a second storage facility for storing metadata describing the digital image (See col. 12, lines 9-44).

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Regarding claims 9, 30, 43, and 55, Stewart discloses identifying a second storage facility comprises encoding account information associated with the digital image (See col. 4, lines 62-65, and col. 12, lines 9-18).

Regarding claims 10, 31, 44, and 56, Stewart discloses wherein the account information comprises a screen name associated with a subscriber (See col. 4, lines 62-65, wherein cookies and authorizations information correspond to account information).

Regarding claims 11, 32, 45, and 57, Stewart discloses mapping the encoded account information to an appropriate storage space group containing second storage facility (See col. 24, lines 10-14, and col. 25, lines 29-65).

Regarding claims 12, 33, 46, and 58, Stewart discloses storing metadata describing the digital image in the second storage facility (See col. 12, lines 9-44).

Regarding claims 13, 34, 47, and 59, Stewart discloses providing access to the stored digital image and the stored metadata (See col. 18, line 40 to col. 19, line 40).

Regarding claims 17-20, Stewart discloses the computer readable medium comprises a disk/a client device/a host device/a propagated signal (See Fig. 2, and col. 6, lines 42-54).

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Regarding claim 22, Stewart discloses a method of monitoring digital images comprising: receiving a complaint associated with a digital image from a first subscriber; and regulating access of the first subscriber to the digital image (See col. 8, lines 45-65, and col. 13, lines 13-26).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 14, 35, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (US 6,389,460), in view of Mattis (US 6,209,003).

Regarding claims 14, 35, and 48, Stewart discloses all the claimed subject matter as set forth above, however, Stewart is silent as to generating the unique hash value comprises applying at least one of the MD5 algorithm and the DEC algorithm to the first and second image identifiers. On the other hand, Mattis teaches using the MD5 algorithm to generate the unique hash value (See Figs. 3A, 3B, and col. 9, line 62 to col. 10, line 10, and also col. 28, lines 35-40). Because Stewart teaches generating the unique hash value (See col. 16, lines 49-59), it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the MD5 algorithm to generate the unique hash value as suggested by Mattis. The motivation would have been to secure the images that are to be transmitted and stored.



*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Midgley U.S Patent No. 6,460,055 discloses systems and methods for backing up data files.

Peters U.S Patent No. 6,292,795 discloses indexed file system and a method and a mechanism for accessing data records from such a system.

Moulton U.S 2001/0037323 discloses Hash file system and method for use in a commonality factoring system.

Kahn U.S Patent No. 6,135,646 discloses system for uniquely and persistently identifying, managing, and tracking digital objects.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marilyn P Nguyen whose telephone number is 703-305-5177. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7240 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN

MN

August 6, 2004

  
SAFET METJAHIC  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100